

Application No. 09/913,617
Amendment and Request for Reconsideration
After Final Rejection dated February 9, 2004
Reply to Office Action of October 21, 2003

PATENT

REMARKS/ARGUMENTS

Claims 25, 26, 29, 30, 34-48, 51 and 52 are presently pending in this application. Claims 1-24, 27, 28, 31-33, 49 and 50 have been canceled.

In the Final Rejection dated October 21, 2003, claims 25, 26, 29-32, 34, 36-41 and 45-47 were rejected for anticipation by Adair because, as is set forth in the earlier Office Action of May 7, 2003, Adair shows amongst others a deformable endoscope with a light and image transmission passage, an additional instrument, such as forceps, and "a holding device (key 36 and keyway 38, or integral magnets 226 and 230) for releasably holding the instrument (122)"

Original claim 1 had previously been replaced by independent claim 25, which, amongst others, recites "a holding device including at least one permanent magnet and at least one counter-element made of magnetic material, holding and/or guiding the fiberscope part and the at least one additional instrument relative to one another"

In the Amendment dated August 6, 2003, applicant pointed out that Figs. 20 to 22 of Adair show an endoscope in which "the removable channel section S_b is attached to the capsule section C_b with a magnetic strip" Applicant further argued in that Amendment:

There is no disclosure in Adair - indeed, there is no mention anywhere in this reference - that the capsule section and the magnetically attached channel sections are, should be, or can be displaced with respect to each other in a longitudinal direction.

In the Final Rejection, independent claim 25 was rejected for anticipation by Adair for the reasons set forth in the earlier Office Action of May 7, 2003. In the Response to Arguments section of the Office Action, the continued anticipation rejection of independent claim 25 was justified as follows:

However, Applicant seems to be equating the channel section (S_b) with the additional instrument recited in the claim. In contrast, the forceps (30 or 122) correspond to the claimed additional instrument. Claim 25 calls for the fiberscope part and the at least

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one additional instrument to be displaceable relative to one another in the longitudinal direction of the unit. Although the channel section and the capsule section (fiberscope part) may not be, the forceps (122) and capsule section are. Note that the previous rejection with respect to Adair equates the additional instrument to the forceps (122).

By arguing that the channel section S_b is to be equated with the "additional instrument" recited in the claim, applicant necessarily disagreed that, for purposes of the magnetic connection disclosed by Adair, forceps 122 of Adair are to be equated with the additional instrument in the claim. Applicant herewith explicitly points out that the two should not be and cannot be equated.

Adair does not disclose or in any form suggest a holding device that includes at least one permanent magnet and at least one counter-element made of magnetic material, holding and/or guiding the fiberscope part and the at least one additional instrument relative to one another.

In column 9, lines 49-53, Adair states that the endoscope shown in Figs. 20-22 has "a sterilizable capsule C_b to which a separable section S_b is attached by means of a magnetic strip". Figs. 20-22 show cooperating magnetic strips 228, 230 carried by the capsule section and the separable section, respectively. These magnetic strips are a substitute for the tongue and groove connection shown in Fig. 3.

Column 9, lines 52-53 also state that "capsule C_b is substantially identical to capsule C of Fig. 1". Thus, Fig. 1 and Fig. 3 associated therewith can be consulted to determine how the capsule and the cooperating separable section are constructed and function. As stated in column 6, lines 18-19 of Adair, "the separable channel section S is removably connectable to capsule C in a fixed position" This means that the separable section can be slidably moved into its fixed position (with the tongue and groove configuration of Fig. 3) or it can be placed in the fixed position with magnetic strips 228, 230.

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The "fixed position" of section S_b relative to capsule C_b is clearly illustrated in Fig. 20, which shows that the separable section S_b abuts against a shoulder formed by capsule C_b . Thus, while the separable section is removable, it is not movable relative to the capsule in the sense of the movability of the additional instrument recited in claim 25.

Neither the magnetic strips 228, 230 shown in Figs. 20-22 and described in column 9, lines 49-67, nor the groove and tongue connection shown in Fig. 3 constitute a magnetic holding device "holding and/or guiding the fiberscope part and the at least one additional instrument relative to one another ... so that the fiberscope part and the additional instrument [are] displaceable relative to one another in a longitudinal direction of the unit", as is recited in claim 25. The only element in Adair that holds the "at least one additional instrument" is the relatively larger instrument passageway 215 (col. 9, line 58) or the corresponding larger central channel 28 in Fig. 4. Passageway 215 and central channel 28 are both provided so that "an operative tool, such as tool 30 shown in Fig. 4, can be provided. Although the tool is illustrated as being forceps, it will be understood that other instruments may be utilized." (col. 6, lines 27-31 of Adair). The only element that holds and/or guides the additional instruments (e.g. forceps) is passageway 215 (Fig. 22) or large central channel 28 (Fig. 3). The fact that section S is separable from the capsule C is entirely irrelevant to the holding and guiding function for the additional instruments. It is equally immaterial whether section S is attached to the capsule with a tongue and groove arrangement (Fig. 4) or with magnetic strips (Figs. 20-22). For "holding and/or guiding the fiberscope part and the at least one additional instrument relative to one another", as recited in claim 25, capsule C and section S could be made of a single piece without either a magnetic or a groove and tongue connection without in any way affecting the holding and/or guiding of the additional instrument relative to the fiberscope part.

There is no suggestion anywhere in Adair, much less does the reference disclose, to hold and/or guide the additional instrument (e.g. forceps) with a permanent magnet and a magnetic counter-element as recited in claim 25 so that the additional instrument is displaceable in a longitudinal direction. Section S of Adair is neither an instrument, as the term is used in the

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specification and claim 25, nor is the section longitudinally displaceable. To be operative, it is connected to the capsule "in a fixed position" (col. 6, line 19 of Adair).

It is inappropriate to reject claim 25 for anticipation by Adair simply because Adair shows a magnetic coupling between two parts which could be made as a single part without in any way affecting the holding and guiding of the additional instrument such as a forceps. The magnetic strips of Adair play no role in holding and/or guiding the additional instrument.

In this context, applicant also acknowledges that Fig. 16 of Adair makes reference to a magnet 185. That magnet is used for moving the endoscope along a desired path and, like magnets 228, 230 shown in Figs. 20-22, has nothing to do with holding and/or guiding the additional instrument.

In view of the foregoing, applicant submits that Adair does not anticipate independent claim 25, and the remaining dependent claims, nor does it render them obvious.

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CONCLUSION

This application is therefore in condition for allowance, and a corresponding notification at an early date is requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,


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